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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,487	12/27/2000	John J. Giobbi	MD-1	5898
21186	7590	11/16/2005		
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH 1600 TCF TOWER 121 SOUTH EIGHT STREET MINNEAPOLIS, MN 55402			EXAMINER JACKSON, JENISE E	
			ART UNIT 2131	PAPER NUMBER

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/750,487	Applicant(s) GIOBBI, JOHN J.	
	Examiner Jenise E. Jackson	Art Unit 2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 26-47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. More specifically Independent claims 26, 32, 38, 44, and 47 contain new matter. The limitations of these claims that contain new matter are, “unmodifiable”, “wherein the unique key code from the key provider is usable for more than one download of more than one type of digital content from more than one content provider”, and a “reader-decoder circuit capable of decryption”. Thus, because claims 26, 32, 38, 44, and 47 contain limitations that describe new matter, “unmodifiable”, “wherein the unique key code from the key provider is usable for more than one download of more than one type of digital content from more than one content provider”, and a “reader-decoder circuit capable of decryption”, these limitations hold no patentable weight and will not be considered as applying prior art. First, the limitation of “unmodifiable” is new matter, because it is not described in the specification. The specification discloses a physical electronic key containing a key code from a key provider(see pg. 3). The specification does not describe or suggest how the physical electronic key is unmodifiable. Second, the limitation of “wherein the unique key code from the key provider is usable for more

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than one download of more than one type of digital content from more than one content provider”, is new matter, because it is not described in the specification. The specification discloses the user transmits the key code to a digital content provider who has a relationship with the key provider, and request to purchase digital content music, video or software from that provider(see pg. 6). Thus, the specification describes the user purchasing a single content from single provider. Also, the specification discloses that the content provider delivers the encrypted digital content to the user, this may be delivered by downloading the encrypted digital content to the user’s computer(see pg. 7). Thus, the key is used for one digital content per download. Lastly, the limitation of the reader-decoder circuit capable of decryption is new matter. The specification discloses the device has decryption software for decrypting the encrypted digital content(see pg. 8). There is no disclosure of a reader-decoder circuit capable of decryption.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 26-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spies(6,055,314) in view of Rallis et al.(6,425,084).

5. As per claims 26, 32, 38, 44, 47, Spies et al. discloses a method of acquiring and playing digital content(see col. 2, lines 25-26), acquiring a physical key(i.e. IC card/smart card)(see col. 2, lines 50-67) containing key code from a key provider(see col. 5, lines 45-47, 55-67, col. 6, lines 19-28); requesting digital content from a content provider(see col. 4, lines 61-67, col. 5,

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lines 10-18); after locking(i.e. encrypt) the digital content with an unlock code associated with the key code contained in the physical key(see col. 3, lines 20-51), receiving the locked digital content; and entering the locked digital content into a playing device that reads the key code and determines whether the key code is associated with the unlock (see col. 2, lines 54-58, col. 3, lines 5-13, col. 6, lines 19-33), the device being enabled to unlock code(see col. 6, lines 19-33). Spies discloses a physical key being a physical object adapted to be carried by a user apart from the playing device(col. 5, lines 62-67, col. 6, lines 25-31). Although, Spies discloses that parts of the system of Spies can be replaced with wireless forms of communication, such as RF communications(see col. 14, lines 55-58). Spies is silent on a wireless key. Rallis discloses a wireless key(i.e. ir key)(see col. 5, lines 44-57). It would have been obvious to one of ordinary skill in the art to include the wireless key of Rallis with Spies, because smart cards are designed for the protection of data and not the deterrence of theft of devices such as a computer(see col. 1, lines 38-41 of Rallis). The motivation to include a wireless device of Rallis with Spies is that a ir key is easy to use and low cost to deter theft of a device(see col. 1, lines 43-44 of Rallis)

4. As per claim 27, Spies et al. discloses the step of acquiring the physical key includes providing the key provider with user identification for use by the key provider in establishing a user account, the user account including the user identification information and the key code(see col. 8, lines 26-55, col. 15, lines 60-67, col. 16, lines 1-2).

5. As per claim 28, Spies et al. discloses including providing the content provider with the key code for use by the content provider in validating the key code prior to providing the locked digital content(see col. 4, lines 61-67, col. 5, lines 10-22, col. 2, lines 54-58).

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6. As per claim 29, Spies et al. discloses wherein the locked digital content is locked by encryption and unlocked by decryption(see col. 3, lines 19-51, col. 6, lines 15-33).

7. As per claim 30, Spies et al. discloses wherein the step of acquiring the physical key(see col. 2, lines 25-26) includes accessing a first web site of the key provider, and requesting the physical key via the first web site(see col. 8, lines 44-46), and wherein the step of requesting the digital content includes accessing a second web site of the content provider, and requesting the digital content via the second web site(see col. 6, lines 34-58).

8. As per claim 31, Spies et al. discloses wherein the physical key is acquired at no charge, and wherein the digital content is purchased(see col. 2, lines 54-58).

9. As per claim 32, Spies et al. discloses a method of managing digital rights(see col. 2, lines 25-31). Further, limitations have already been addressed(see claim 26).

10. As per claim 33, Spies et al. discloses establishing a user account including user identification information and the key code for the requesting user prior to the step of providing the physical key(col. 8, lines 26-55, col. 15, lines 60-67, col. 16, lines 1-2).

11. As per claim 34, Spies et al. discloses obtaining and validating the key code for the requesting user prior to the step of providing the locked digital content(see col. 4, lines 61-67, col. 5, lines 10-22, col. 2, lines 54-58).

12. As per claim 35, Spies discloses including administering a first web site for receiving a request for the physical key from the requesting user(see col. 8, lines 44-46), and administering a second web site for receiving a request for the digital content from the requesting user (see col. 6, lines 34-58).

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13. As per claim 36, Spies discloses wherein the locked digital content is locked by encryption and unlocked by decryption(see col. 3, lines 19-51, col. 6, lines 15-33).
14. Same motivation as above(see claim 26). As per claim 37, Rallis discloses a key code that includes a wireless transceiver (see col. 5, lines 45-57).
15. As per claim 38, it is rejected under the same basis as claim 26.
16. As per claim 39, limitations have already been addressed (see claim 33).
17. As per claim 40, Spies et al. discloses wherein the means for providing the locked digital content to the requesting user includes a web site on the Internet(see col. 6, lines 34-58).
18. As per claim 41, Spies et al. discloses wherein the means for providing the locked digital content secures validation of the key code prior to providing the locked digital content(col. 4, lines 61-67, col. 5, lines 10-22, col. 2, lines 54-58).
19. As per claim 42, it is rejected under the same basis as claim 33.
20. As per claim 43, Spies et al. discloses wherein the means for providing the physical key includes a web site on the Internet (see col. 8, lines 44-46).
21. As per claim 44, limitations have already been addressed (see claim 26).
22. As per claim 45, Spies discloses wherein the digital content is locked by encryption and unlocked by decryption (col. 3, lines 19-51, col. 6, lines 15-33).
23. As per claim 46, Spies discloses wherein the physical key and the playing device include means for communicating the key code to the playing device(see col. 6, lines 19-33).

Response to Amendment

24. The Applicant states that the key permits users to protect multiple pieces of types of content concurrently, while also securing hard drives, online banking/credit card transactions and

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access to physical items. Although, the claimed invention discloses a key that can be used for more than one type of digital content. The specification does not disclose a key that can be used for more than one type of digital content. The specification discloses a user transmits the key code to a content provider, and requests to purchase digital content(music, video or software)(see pg. 6). The specification discloses that user request to purchase a digital content, that can be music, video or software(see pg. 6). There is not disclosed in the specification using a key for more than one type of digital content. Furthermore, the specification does not disclose using a key more than one time. Second, the Applicant stated that the key is used to secure hard drives and online banking/credit card transactions. The specification does not state that the key is used for secure hard drives and online banking. The specification discloses using a credit card to pay for the digital content(see pg. 7). Also, the claims do not disclose using a key for securing hard drives or online banking/credit card transactions; therefore, this point by the Applicant is moot.

25. The Applicant states that the claimed invention does not require a crypto key to be downloaded at all. The claim does not state that the key cannot be downloaded. Therefore, this point is moot. Furthermore, the Applicant is arguing limitations, “unmodifiable, and the unique key code form the key provider is usable for more than one download of more than one type of digital content from more than one content provider”, is not disclosed or described in the specification. Therefore, the amended claims than contain these limitations are rejected under 112 1st as containing new matter(see above). Thus, the amended limitations contain no patentable weight.

26. The Applicant has argued that Spies does not disclose a wireless key. Spies was not relied on for this feature, Rallis discloses a wireless key(see above).

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27. The Applicant states that the content decryption in Spies takes place in the IC card itself. The Applicant states that the claimed invention, decryption takes place in the receiver-decoder circuit. There is no disclosure of a receiver-decoder circuit (see above for rationale). Second, Spies discloses in one embodiment that the IC card can perform the decryption capabilities (see fig. 11, sheet 10). However, Spies discloses another embodiment where the decryption is done at the set top box(see fig. 12, sheet 11).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenise E. Jackson whose telephone number is (571) 272-3791. The examiner can normally be reached on M-Th (6:00 a.m. - 3:30 p.m.) alternate Friday's.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



November 9, 2005


AYAZ SHEIKH

SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100